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Nixon & Vanderhye P.C.
1100 North Glebe Road, 8th Floor
Arlington, VA 22201-4714

In re Application of TATO et al
U.S. Application No.: 10/088,678
Int. Application No.: PCT/IT00/00373
Int. Filing Date: 21 September 2000
Priority Date: 21 September 1999
Attorney Docket No.: 4161-2

For: METHOD FOR THE SELECTIVE
PROTECTION OF PROLIFERATING
NORMAL CELLS AND THE SELECTIVE
ERADICATION OF TUMOR CELLS HAVING
AN INACTIVE p53 PATHWAY

DECISION

This is in response to applicant's "Submission of Inventors' Declaration Under 37 C.F.R. §1.42 and 1.63" filed 16 October 2002.

BACKGROUND

On 21 September 2000, applicant filed international application PCT/IT00/00373, which claimed priority of an earlier Italy application filed 21 September 1999. A copy of the international application was communicated to the USPTO from the International Bureau on 29 March 2001. A Demand for international preliminary examination, in which the United States was elected, was filed on 18 April 2001, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 21 March 2002.

On 21 March 2002, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 18 June 2002, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration and a sequence listing must be filed.

On 16 October 2002, applicant filed the present request for status under 37 CFR 1.42 along with an executed declaration.

DISCUSSION

37 CFR 1.42 provides, "In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent."

In the present case, the declaration filed 16 October 2002 is improper. Specifically, although the sole heirs Claudia Della Valle Simoni, Alessandro Tato, and Francesco Tato may sign the declaration on behalf of the deceased inventor Franco Tato, the heirs may not be listed as inventors. Furthermore, the declaration fails to list Franco Tato as an inventor.

Applicant is advised that the submission of a declaration executed by the sole heirs of the deceased inventor is hereby construed as an indication that no legal representative of the deceased's estate has been appointed and that no legal representative is required by the applicable law to be appointed. If this interpretation is incorrect applicant is required to promptly notify the Office of such and to submit a declaration properly executed by the legal representative of the deceased inventor in response to this decision.

Applicant is further advised that, effective 07 November 2000, 37 CFR 1.497(b)(2) specifies that, where a person making the declaration is the legal representative of a deceased inventor, the declaration shall state the following: (1) the relationship of the person to the inventor, (2) the facts the inventor would have been required to state, upon information and belief, (3) that the person is the legal representative of the deceased inventor, and (4) the citizenship, residence, and mailing address of the legal representative.

CONCLUSION

For the reasons above, the request for status under 37 CFR 1.42 is DISMISSED without prejudice.

The portion of the Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) which indicated that a sequence listing must be filed is hereby VACATED.

If reconsideration on the merits of the request for status is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Extensions of time are available under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Request for Status Under 37 CFR 1.42". No petition fee is required.

Please direct further correspondence with respect to this matter to the Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.

A handwritten signature in black ink, appearing to read "Bryan Tung", written in a cursive style.

Bryan Tung
PCT Legal Examiner
PCT Legal Office

Telephone: 703-308-6614
Facsimile: 703-308-6459